

Notice of Allowability**Application No.**

10/718,403

Examiner

Evelyn Huang

Applicant(s)

BREITFELDER ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed on 9-24-2004.
2. ☒ The allowed claim(s) is/are 1-21 and 25-29.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

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EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Ms. Small on 12-21-2004. During the interview, the examiner suggested amending claims 6, 7 to better define the claims, deleting '2-chloro-4-trifluoromethylphenyl' in the proviso of claim 25 because it had no antecedent basis, and canceling claims 22-24 to place the application in conditions for allowance.

Since the compound claims are allowed, the withdrawn method claims 22-24 have been rejoined. However, these method claims have 112 first paragraph issues.

The application has been amended as follows:

- a. Claim 6, definition of R4, after 'R4 is C1-C3-alkyl optionally substituted by hydroxy, fluorine, or -CF₃,' , insert - or --.
- b. Claim 7, definition of R4, after 'R4 is C1-C3-alkyl optionally substituted by hydroxy, fluorine, or -CF₃,' , insert - or --.
- c. Claim 25, on page 18 of the amendment, in the first proviso, delete '2-chloro-4-trifluoromethylphenyl'.
- d. Cancel claims 22-24.

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance:

Claims 1-21, 25-29 are allowed.

The amendment has obviated the 35 U.S.C. 112 second paragraph rejection.

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The rejection for claims 1-4, 8, 12, 21 under 35 U.S.C. 103(a) as being unpatentable over King (4797387) is withdrawn in view of the amendment deleting –CH₂-CH₂- from the definition of A and deleting chlorine from the substituents on the aryl in the definitions of R₃ and R₄, thereby setting a demarcation from the compound of King. Lacking is the motivation to modify King's 5-HT antagonist compound via multiple changes to arrive at the instant invention.

The rejection for claims 1-4, 8, 12, 16, 21 under 35 U.S.C. 103(a) as being unpatentable over Takeuchi (EP 747 355) is withdrawn in view of the amendment deleting –CH₂-CH₂- from the definition of A, and deleting chlorine from the substituents on the aryl in the definitions of R₃ and R₄, thereby setting a demarcation from the compound of Takeuchi. Lacking is the motivation to modify Takeuchi's compound via multiple changes to arrive at the instant invention.

The rejection for Claims 25-27 under 35 U.S.C. 103(a) as being unpatentable over Mach (6113877) is withdrawn in view of the amendment deleting chlorine from the substituents on the aryl in the definitions of R₃ and R₄, thereby setting a demarcation from the compound of Mach. Lacking is the motivation to modify Mach's compound via multiple changes to arrive at the instant invention.

The rejection for Claims 1-6, 8-10, 12-14, 21 under 35 U.S.C. 103(a) as being unpatentable over Mach (6113877) in view of King (4797387) and/or Takeuchi (EP 747 355) and/or Banholzer (5770738) is withdrawn in view of the amendment deleting –CH₂-CH₂- from the definition of A, and deleting chlorine from the substituents on the aryl in the definitions of R₃ and R₄, thereby setting a demarcation from the compound of Mach. Lacking is the motivation to modify Mach's compound via multiple changes to arrive at the instant invention.

3. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 571-272-0686. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Evelyn Huang

Primary Examiner

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